

Remarks: Requirement for Restriction

The Requirement for Restriction should not have been made because the Independent Claims had already received an action on the merits and had been allowed. In particular, Claims 1-11 and 13-32 were allowed in the Office Letter mailed on 08/08/2003.

Applicant cancelled Claim 12 and made minor amendments to some of the allowed claims in a response mailed on 11/07/2003. This should have put the application in condition for allowance. Applicant then added 91 Dependent Claims in an amendment filed on 11/19/2003. In response to the letter mailed on 11/19/2003, the Examiner issued a Requirement for Restriction. The addition of the Dependent Claims to this case should not result in a Requirement for Restriction and should require very little of the Examiner's time for consideration because the pending Independent Claims have already been allowed.

Accordingly, **M.P.E.P. 810.02** states that:

"The Office policy is to usually defer action on the merits until after the requirement for restriction is complied with, or withdrawn. Ex parte Pickles, 1904 C.D. 126, 109 O.G. 1888 (Comm'r Pat. 1904); Ex parte Snyder, 1904 C.D. 242, 110 O.G. 2636 (Comm'r Pat. 1904); and Ex parte Weston, 1911 C.D. 218, 173 O.G. 285 (Comm'r Pat. 1911)."

Furthermore, **37 CFR 1.142(a)**, second sentence, states: "[i]f the distinctness and independence of the invention be clear, such requirement will be made before any action upon the merits; however, it may be made at any time before final action in the case at the discretion of the examiner." This means the examiner should make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as the need for a proper requirement develops.

The addition of Dependent Claims to a case in which Independent Claims have already been allowed should not constitute a need for requirement for restriction.

The Office letter mailed on 01/28/2004 (in which the Requirement for Restriction was made) is responsive to Applicant's letter filed on 11/19/2003 in which the Dependent

Claims were added. However, **the addition of Dependent Claims should not be grounds for a Requirement for Restriction.** For example,

M.P.E.P. 806.04(d) states, “Once a claim that is determined to be generic is allowed, **all of the claims drawn to species in addition to the elected species which include all the limitations of the generic claim will ordinarily be obviously allowable in view of the allowance of the generic claim,** since the additional species will depend thereon or otherwise include all of the limitations thereof.”